

## **REMARKS**

In the Office Action mailed October 21, 2005, the office action withdrew the previously indicated allowability of claims 35-37, 41, 43, and 44 in view of a new interpretation of the prior art of record. Claims 30, 32 and 38 were rejected for alleged obviousness under 35 USC 103(a) over Petersen (U.S. Patent No. 5,479,797) in view of deJong (U.S. Patent No. 4,612,719) and Tokunaga (U.S. Patent 5,168,281). Claims 35-37, 41, 43 and 44 were rejected for alleged obviousness under 35 USC 103(a) over MacDonald (U.S. Patent No. 5,323,554) in view of deJong (U.S. Patent No. 4,612,719) and Tokunaga (U.S. Patent 5,168,281).

Contrary to the statement in the Office Action, Applicant has never admitted, in the specification or otherwise, that de Jong, Tokunaga or any other patent identified in the Office Action constitutes art. That part of the specification referenced in the Office Action reads as follows:

“Unfortunately, available RF circuits are relatively expensive and, since conventional wristbands are disposable after use, such circuits would have to be discarded if they were integral components of the wristband.” (page 3, lines 5-8)

The specification immediately preceding this statement discusses the inclusion of RF circuits and antennas in wristbands to make available a wide spectrum of information compared to bar-codes or the like. The cited paragraph discusses the drawback of including expensive RF circuits in wristbands, which are conventionally disposable, requiring that the RF circuit be disposed of along with the wristband.

### **35 USC § 103 - Obviousness**

To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP §2143.03 (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)). All words in a claim must be

considered in judging the patentability of that claim against the prior art. *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970).

The Office Action picks and chooses aspects of the prior art references in light of the claims in attempting to reconstruct Applicant's invention. The assertions are not supported by the references, but arise from impermissible hindsight based upon the teachings of Applicant's invention.

"When prior art references require selective combination . . . to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself . . . ."

*Uniroyal Inc. v. Rudkin-Wiley Corp.*, 5 USPQ.2d 1434, 1438 (Fed. Cir. 1988)

The present invention claims as a necessary limitation in claims 30, 35, 38 and 41:

"an antenna carried by said strap, and coupling means for operatively and **removably** connecting said antenna with said radio frequency identification circuit when said securement means is connected to said strap, and for **disconnecting** said antenna from said radio frequency identification circuit when said securement means is disconnected from said strap" (emphasis added)

This claim limitation, which appears in each independent claim, requires that the radio frequency identification circuit be removably connected to the antenna; capable of being disconnected therefrom when the strap is removed from the securement means; and subsequently connected to another antenna when another strap is connected thereto.

Tokunaga does not teach or disclose such a removable configuration. In fact, Tokunaga teaches away from a removable configuration.

"Connector 5 and connection terminal 4 are preferably fixed in place by caulking. Caulking is a mechanically performed **permanent securing process**. In this case, after the axis of connector 5 is set in the aperture of connection terminal 4, plastic deformation is performed on the tip of the axis to make it larger than the diameter of the aperture so that it is **permanently**

secured. However, their mechanical strength and electrical properties will last for a long period of time if they are soldered together.

The permanent securing of connector 5 and connection terminal 4 either by means of caulking or soldering is performed before wristband 2 is removably secured to casing 1 by attachment screws 14. Wristband 2, antenna 3, connection terminal 4, connector 5 and packing 6 are assembled as one unit and then mounted on casing 1." (emphasis added) (Tokunaga, col. 5, lines 44-60).

Tokunaga teaches permanent affixation of the antenna to the contact in the casing. In addition, Tokunaga teaches the permanent connection of an antenna to a contact in a casing, rather than to a contact in a securement means. Tokunaga does not disclose but implies that there is a securement means (i.e., a buckle) located on the wristband opposite the casing with no electrical connection to the antenna. Thus, Tokunaga is antithetical to the teachings of the claimed invention and the combination of Tokunaga with Petersen and de Jong or MacDonald and de Jong constitutes hindsight reconstruction based upon the teachings of the claimed invention.



**Conclusion**

In view of the foregoing remarks, claims 30, 32, 35-38, 41, 43, and 44 are submitted for reconsideration and allowance. A Notice of Allowance is believed to be in order, and is therefore respectfully requested.

Respectfully submitted,

KELLY LOWRY & KELLEY, LLP

A handwritten signature in black ink, appearing to read "Scott W. Kelley".

Scott W. Kelley  
Registration No. 30,762

SWK:cw  
6320 Canoga Avenue, Suite 1650  
Woodland Hills, California 91367  
(818) 347-7900